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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ISMAIL, SHAWKI SAIF

ART UNIT PAPER NUMBER

2155

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/987,889	Applicant(s) MOROO, JUN	
	Examiner Shawki S. Ismail	Art Unit 2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. This communication is responsive to the RCE received on October 6, 2005. Claims 1, 10, and 19 were amended. Claim 24 was newly added. Claims 1-24 are presented for examination.

### **The Old Rejection Maintained**

2. The rejection is respectfully maintained as set forth in the last Office Action mailed on July 6, 2005. Applicants' arguments with respect to claims 1-23 and newly added claim 24 have been fully considered but they are deemed to be moot and old rejection is maintained.

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1, 10 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation wherein a message holder for temporarily holding every electronic message except said last-named electronic message so as to be browsed by the user from said terminal, contains subject matter which was not mentioned in the

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disclosure of the patent application let alone explained in such a way as to enable one skilled in the art to understand its relevancy to the scope of the claim. It is unclear why the last-named electronic message is not temporarily stored in the message holder. Contrary to the amended claims above, the disclosure of the patent application discloses temporarily storing every electronic message from any sender in the message holder. An explanation of where the specification supports the claim language is needed so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For the sake of expediting prosecution the examiner will interpret "sender data" to be "the data or content which is contained in the sent message" If applicant believes that this is not a fair interpretation, applicant needs to state otherwise.

5. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 23 contains "sender data" it is unclear from the disclosure of the patent application what the sender data entails. It is understood from the disclosure specifically paragraph ([0038], [0048] and [0065]) of the patent application publication that sender information refers to the sender's mail address). An explanation of where the specification supports the claims language is need so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

### **Claim Rejections - 35 USC §102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-23, are rejected under 35 U.S.C. 102(e) as being anticipated by **Voticky et al.**, (Voticky) U.S. Patent No. **6,351,764**.

8. As to claim 1, Voticky teaches an electronic message delivery system comprising:

a terminal from which a user is able to browse electronic messages, electronically sent out on a communications network and addressed to the user (col. 2, line 64 – col. 3, line 9); and

an electronic message delivery management server for managing delivery of the electronic message delivery management server including:

(a) a permitted-sender list in which permitted-sender information about a permitted sender, whose every electronic message is permitted to be received by the user on said terminal, is registered (Fig. 3, col. 4, lines 14-24);

(b) sender information obtaining means for obtaining sender information from an individual electronic message addressed to the user (Fig. 3);

(c) checking means for checking as to whether or not said sender information, which has been obtained by said sender information obtaining means, of the last-named individual electronic message is identical with said permitted-sender information registered in said permitted-sender list (Fig. 2, col. 4, lines 41-50);

(d) delivering means for delivering said last-named electronic message, which contains said last-named sender information registered in said permitted-sender list, to the user if the result of the checking by said checking means is positive (col. 4, lines 55-62);

(e) a message holder for temporarily holding every electronic message except said last-named electronic message so as to be browsed by the user from said terminal (col. 4, lines 55-62);

(f) storing control means for storing the last-named electronic message into said message holder if the result of the checking by said checking means is negative (col. 4, lines 55-62);

(g) browsing control means for allowing the individual electronic messages, which have been temporarily held in said message holder, to be browsed by the user from said terminal upon a browsing request of the user from said terminal (Fig. 3);

(h) link setting means for setting a link between said sender information of an individual electronic message, which has been temporarily held in said message holder, and said permitted-sender list while the user is browsing the last-named individual electronic message from said terminal (fig. 4); and

(i) registering means for registering said sender information of an electronic message in said permitted-sender list when the sender of the last-named electronic message is selected as a newly permitted sender by the user from said terminal (col. 8, lines 35-45), and wherein said electronic message delivery management server distributes the electronic messages to said terminal, allows the individual electronic messages to be browsed by the user from said terminal upon the browsing request, sets the link between said sender information and said permitted-sender list, and registers said sender information in said permitted-sender list (see Fig. 4, col. 6, lines 18-33, col. 8, lines 35-45).

9. As to claim 2, Voticky teaches an electronic message delivery system according to claim 1, further comprising notifying means for notifying the user that an electronic message has been held in said message holder, if said message holder holds the last-named electronic message therein (col. 9, lines 32-46).

10. As to claim 3, Voticky teaches an electronic message delivery system according to claim 2, wherein said notifying means performs the notification of said last-named electronic message held in said message holder, at prescribed time intervals (col. 9, lines 32-46).

11. As to claim 4, Voticky teaches an electronic message delivery system according to claim 1, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

12. As to claim 5, Voticky teaches an electronic message delivery system according to claim 2, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

13. As to claim 6, Voticky teaches an electronic message delivery system according to claim 3, wherein said electronic message is an e-mail (Abstract, Fig. 1, col. 3, lines 49-51).

14. As to claim 7, Voticky teaches an electronic message delivery system according to claim 1, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

15. As to claim 8, Voticky teaches an electronic message delivery system according to claim 2, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

16. As to claim 9, Voticky teaches an electronic message delivery system according to claim 3, wherein said electronic message is a voice mail (Abstract, col. 8, lines 64-67).

17. Claims 10-21 are essentially the apparatus and recording medium of the above-mentioned claim; therefore, they are rejected under the same rationale.

18. As to claim 22 Voticky teaches a method of managing an electronic message, comprising:

categorizing the electronic message in accordance with stored sender information upon receipt of the electronic message by a server (see Fig. 3, mail is prioritized or categorized according to the assigned codes); and



automatically transmitting a notification related to the categorized electronic message to a terminal, and enabling a user of the terminal to link sender data of the categorized electronic mail to the stored sender information while browsing contents of the electronic message (Fig. 4 and (col. 9, lines 32-46, the user is then presented with the categorization of the electronic messages among different mailboxes) .

19. As to claim 23 Voticky teaches an apparatus for managing an electronic message, comprising:

means for categorizing the electronic message in accordance with stored sender information upon receipt of the electronic message by a server(see Fig. 3, mail is prioritized or categorized according to the assigned codes);

means for automatically transmitting a notification related to the categorized electronic message to a terminal means for enabling a user of the terminal to link sender data of the categorized electronic mail to the stored sender information while browsing contents of the electronic message (Fig. 4 and (col. 9, lines 32-46, the user is then presented with the categorization of the electronic messages among different mailboxes).

20. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by **McCormick et al.**, (McCormick) U.S. Patent No. **6,421,709**.

21. As to claim 24, McCormick teaches a method of delivering received electronic messages, comprising:

delivering an electronic message among the received electronic messages to a first mailbox upon determining that a sender of the electronic message matches

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registered sender information, all other received electronic messages being delivered to a second mailbox (see Fig. 2, col. 2, line 50 – col. 3, line 5, col. 6, lines 28-50, incoming messages that match addresses in the guest list are forwarded to the inbox, otherwise they are either discarded depending on if they are in the no admit list or are sent to a waiting room for viewing by the user);

allowing a user to browse through contents of the electronic messages in the second mailbox (see Fig. 2, col. 2, line 50 – col. 3, line 5, col. 6, lines 28-50, the user is able to view the messages in the waiting room); and

delivering a selected electronic message in the second mailbox to the first mailbox responsive to the user registering sender information of the selected electronic mail while browsing through the electronic messages in the second mailbox (see Fig. 2, col. 2, line 50 – col. 3, line 5, col. 6, lines 28-50, the user browses the messages in the waiting list and may add selected messages to the guest list or the inbox if the message is deemed desirable).

### **Response to Arguments**

22. Applicant's arguments filed on October 6, 2005 have been fully considered but they are not deemed to be persuasive.

Argument: Applicant argues in substance that Voticky does not teach or suggest, "temporarily holding every electronic message except said last-named electronic message so as to be browsed by the user."

Response: As indicated in the 112 rejection above it is unclear why the last-named electronic message is not temporarily stored in the message holder. Until a time when

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such clarity is provided, the examiner reserves the right to respond to the applicant's argument at that time.

Argument: Applicant argues that "enabling a user of the terminal to link sender data of the categorized electronic mail to the stored sender information while browsing contents of the electronic message"

Response: Voticky sorts all incoming mail and categorizes them in specific mailboxes (refer to Fig. 4). At the user terminal, the user is able to view each message based on the sender's information (sender's address) and correlate or link the identified sender's address with the content of the mail while browsing the contents of the electronic message and therefore Voticky meets the scope of the claimed limitation (col. 6, lines 18-33).

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail  
Patent Examiner  
June 29, 2005



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